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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,794	12/01/2000	Lynn T. Rowe	98,597-B	3095

7590 03/08/2006  
McDonnell Boehnen Hulbert & Berghoff  
Suite 3200  
300 South Wacker Drive  
Chicago, IL 60606

EXAMINER
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TRAN, HAI V

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/728,794

Applicant(s)

ROWE ET AL.

Examiner

Hai Tran

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-16 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 15- 16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 12/30/2005 have been fully considered but they are not persuasive.

Applicant argues, "Applicants submit that Kuwabara does not teach 'digital interactive streaming media', as described in the present application and recited in claim 13. "

In response, the Examiner respectfully disagrees with Applicant because Kuwabara discloses "interactive streaming media" which allows user to interact to do shopping as disclosed (Col. 27, lines 34-60) and cites "REMOTE CONTROL 1109 is used for clicking and selection icons and the like shown on the screen by remote control while viewing the screen..."

Applicant further argues, "In addition, within Applicant's system, the 'interactive programming' as recited in claim 13 includes raw data that is manipulated by a set top application system to produce 'broadcast quality interactive programming'."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the interactive programming includes raw data that is manipulated by a set top application system to produce broadcast quality interactive programming") are not recited in the rejected claim(s). Although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues, “The interactive media taught in Kuwabara is not a ‘broadcast quality’ television, as recited in claim 13, but rather still pictures overlaid on a TV program because the shopping program is transmitted as frames of data that comprise still photographic information (no full-motion video).”

In response to applicants’ arguments, the recitation “provides different broadcast quality interactive programming ...”, or “broadcast quality” as recited in claim 13, has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Moreover, limitation “broadcast quality” does not and is not “media that includes full motion video suitable for display on a television, such as, for example, at 24 or 30 frames per second”, as argued by Applicant. “broadcast quality” is a very broad term in which “quality” is very subjective term and cannot be measured/defined/evaluate with precision, for example. Thus, “Broadcast quality” can be broadly read as bandwidth availability during broadcasting, error free broadcasting, broadcast image (resolution)

quality, broadcast with quality of content, etc... The Examiner takes note the above Applicant's remark; however, Applicant's remark could not be imported into the claim. Therefore, the Examiner could not consider Applicant 's remark.

### ***Election/Restrictions***

Newly submitted claims 15-16 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Limitations in claims 15-16 are derived from the previous non-elected claims 1-12. Applicant is not allowed to switch to a non-elected invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-16 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 13-14 rejected under 35 U.S.C. 102(b) as being anticipated by Kuwabara et al. (US 5909439).

Claim 13, Kuwabara discloses an interactive information distribution system delivering digital program information over a large geographic area wherein the digital program information provides different broadcast quality TV programming to a plurality of remote locations within the geographic area (Fig.13), the system comprising:

a network operations center (Fig. 6, el. 1300) providing national programming and multiplexing interactive programming to create a digital interactive streaming media (Col.28, lines 4-15; lines 44-65); in view of Applicant 's specification, limitation "creating national programming" reads on the TV Broadcasting Transmission System 1302 in which inherently provide National TV programs, i.e. TV programs, see Col.26, lines 58-65; Col. 27, lines 40-46 and Col. 27, lines 34-60

a distribution system (Fig. 3, el. 1) transmitting the digital interactive streaming media to the plurality of remote locations (Fig. 3, el. 3A..N), see Col. 25, lines 49-65;

Kuwabara further discloses a set top application system to process the interactive programming to be displayed to viewers (Fig. 4; Col. 26, lines 65-+), wherein the interactive programming is carried by the digital streaming media and enables viewer to select displayed items for purchase, and a return network to communication transactional information from the remote location to provide interactive programming capability (Fig. 4, el. 1108 for uplink; Col. 27, lines 34-65+).

Claim 14, Kuwabara further discloses wherein the interactive programming offers services for purchase from commercial providers (Fig. 6; el.1314; Col. 23, lines 60-65; Col. 28, lines 8-15).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

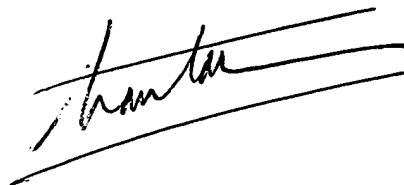
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on (571) 272-7294. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT:ht  
02/27/2006

A handwritten signature in black ink, appearing to read "HAITRAN", is written over three horizontal lines.

**HAITRAN  
PRIMARY EXAMINER**